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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/895,304 | 06/29/2001 | Rod Ross | 155615-0024 | 2393 |

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT PAPER NUMBER

3731

DATE MAILED: 12/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,304

Applicant(s)

ROSS ET AL.

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 45 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-26 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 45 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,165,189 to Ziemer. Ziemer discloses a blade assembly meant to be used with a microkeratomes to cut a cornea. The microkeratome has a pin (89). Ziemer's blade holder (3) has a recess (59) that receives pin (89) [Column 3, lines 60-63; Fig. 8A]. Ziemer discloses a blade (4) attached to the blade holder (3) [Column 3, lines 13-17]. The blade has a pair of side edges (on the left and right looking at Fig. 8C), a cutting edge (5), a rear edge (top, looking at Fig. 8C), and notches (lower left and lower right, looking at Fig. 8C). Each notch is located between the cutting edge (5) and the front surface (assumedly, Applicant means the "front surface" of the blade holder) along each side of the blade. As components (47) of the blade holder are inserted into the holes (48) in the blade, each notch will be located between the cutting edge (5) and the blade holder.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 21, 23, and 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellenkamp in view of US Patent No. 6,228,099 to Dybbs.

Hellenkamp includes all the limitations of claims 21 and 24, except for a bonding agent and a hole. The blade and blade holder are interlocked by holes on the blade and protrusions on the blade holder (Figures 6A-6C). It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the interlocking structure so that the holes are on the blade holder, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. Dybbs discloses a microkeratome with a blade (98) and blade holder (100,96). Dybbs teaches that adhesive can be used with interlocking structures of a blade assembly (column 9, lines 35-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply adhesive to the interlocking structure of the blade and blade holder of the Hellenkamp device, as taught by Dybbs, as the addition of adhesive ensures a more secure attachment between two interlocking parts of a blade assembly.

Because Claims 21 and 24 are product claims (rather than a process claims), they are not construed as being limited to the product formed by the specific process recited. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable.

Art Unit: 3731

3. Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellenkamp in view of Dybbs, as applied to claims 21 and 24 above, and further in view of Richey.

Hellenkamp, as modified by Dybbs above, includes all the limitations of claims 22 and 25, except for the front surface of the blade holder including a raised surface. Richey teaches that the front surface of a blade holder (42) can include a raised surface (44C), as shown in Figure 5. Figure 7 illustrates a plurality of raised surfaces (44E). Richey teaches that this structure helps to secure the blade holder to the microkeratome by friction fit (column 4, lines 25-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a raised surface on the front of the blade holder of the modified Hellenkamp device, as taught by Richey, as this provides a more secure fit between the blade holder and microkeratome.

4. Claims 21 and 24 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Hellenkamp in view of US Patent No. 5,938,676 to Cohn et al. Hellenkamp includes all the limitations of claims 21 and 24, except for a bonding agent and a hole. The blade and blade holder are interlocked by holes on the blade and protrusions on the blade holder (Figures 6A-6C). It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the interlocking structure so that the holes are on the blade holder, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. Cohn discloses a blade and a blade holder (336) and a blade holder (320), very similar to the Hellenkamp device. Cohn teaches applying a bonding agent to attach a blade to a blade holder in order to

Art Unit: 3731

make the attachment permanent [Column 7, lines 43-57]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a bonding agent to the interlocking structure of the blade and blade holder of the modified Hellenkamp device, as taught by Cohn, in order to cause the attachment to be more permanent and rigid.

As mentioned above, because Claims 21 and 24 are product claims (rather than a process claims), they are not construed as being limited to the product formed by the specific process recited. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,807,623 to Lieberman

U.S. Patent No. 6,540,760 B2 to Austring et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3731

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

BCP
BCP


MICHAEL J. MILANO
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